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Paper No. 21

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In re Application of
Solomon Edlin
Application No. 09/871,383
Filed: May 31, 2001
Attorney Docket No.

: **OFFICE OF PETITIONS**
:
: **ON PETITION**
:
:

This is a decision on the renewed petition under 37 CFR 1.137(a), filed May 5, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.137." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Nonprovisional Application (Notice) mailed September 11, 2001. The Notice set a period for reply of two (2) months from the mail date of the Notice. A two (2) month extensions of time under the provisions of 37 CFR 1.136(a) were obtained.¹ Accordingly, the above-identified application became abandoned on February 12, 2002.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof; (2) the petition fee required by 37 CFR 1.17(l); (3) an adequate showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a

¹ The fee for a three (3) month extensions of time was \$460.00 and petitioner paid \$330.00.

grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) for an application filed prior to June 8, 1995. This petition lacks item (3).

The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). See MPEP 711.03(c)(III)(c))(2) for a discussion of the requirements for a showing of unavoidable delay.

On the renewed petition, applicant asserts that the delay in responding to the Notice was unavoidable because, "...no access to patent fund of U.S.... Did not know Patent laws and rules of U.S.... moreover condition of health did not permit me to answer quicker." A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

While petitioner's illness was indeed unfortunate, the showing of unavoidable delay is insufficient. If the delay was in fact due to petitioner's medical condition, petitioner has not provided any evidence to show the dates, nature, and degree of petitioner's illness. Additionally, there is no statement from petitioner's attending physician regarding whether or not petitioner's illness during the period in question would have prevented him from timely responding to the Office action. Without a doctor's statement as to the dates, nature, and degree of petitioner's illness during the period in question, it cannot be concluded that petitioner's illness asserted to have prevented him from timely responding to the outstanding Office action was such as to constitute unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).

Under the circumstances, petitioner has not carried his burden of proof to show that the delay was unavoidable as required by statute and by regulations of the U.S. Patent and Trademark Office. Petitioner is reminded that a petition to revive an application under 37 CFR 1.137(a) cannot be granted where a petitioner has failed to meet his burden of establishing unavoidable delay within the meaning of 37 CFR 1.137(a) and 35 USC 133. Hainves v. Quigg, 673 F. Supp. 314, 5 USPQ2 1130 (N.D. Ind. 1987).

While the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable, petitioner is not precluded from obtaining relief by filing a petition pursuant to 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m);² (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay

² An addition of \$50.00 is required for processing a returned check.

was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to paragraph (d) of this section.

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement of unintentional delay is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

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 U.S. Patent and Trademark Office
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 Crystal Plaza Two Lobby, Room 1B03
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By fax: (703) 872-9306
 ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 306-5685.³



Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

³ Effective September 27, 2004, the phone number will be 571-272-3220.